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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,516

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Tadayasu Koga

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02/06/2008

OLIFF & BERRIDGE, PLC

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EXAMINER

LALLI, MELISSA LYNN

ART UNIT

PAPER NUMBER

4124

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,516	<b>Applicant(s)</b> KOGA ET AL.	
	<b>Examiner</b> MELISSA L. LALLI	<b>Art Unit</b> 4124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☒ Claim(s) 6 and 12-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/28/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Amendment***

1. Applicant is reminded of the proper form of amendments because of the supplemental amendment submitted on 28 December 2005. The supplemental amendment was non-compliant with non-compliant with 37 CFR 1.121 since claims 13-15 were not listed.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is two paragraphs and it is more than 150 words. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 5, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,311,248 to Marchant (Marchant) in view of 4,310,101 to Sekine (Sekine).

In Reference to Claim 1:

Marchant teaches:

A refill case comprising: a middle plate (see fig. 2, inner shell 10) in the shape of a bottomed short cylinder (see col. 1, lines 66-67) containing a cosmetic item (see col. 1, lines 9-13 and 21-25) and having outward brim (see fig. 2, rim 13) along the upper periphery of said plate; a case body (see fig. 2, outer shell 15), which accepts and keeps said middle plate in a storage cylinder under the condition that said brim sits on the top flat rim of this storage cylinder (see col. 2, lines 26-31); and a cap, which is fitted around said case body detachably in screw engagement, and which is used to seal said middle plate (see col. 2, lines 49-57)

Marchant fails to teach the following claimed limitation that is taught by Sekine:

a cap (see fig 1, cap arrangement 8), which is used to seal said middle plate through tight contact of said brim with a ring-shaped gasket (see fig. 1, packing arrangement 18) made of a soft, elastic material (see col. 3, lines 45-47), said gasket being embraced by the underside of roof (see fig.1, closed top 11) and fitted thereto in an undetachable manner but in a state having play relative to said roof (see col. 2, lines 63-68 and col. 3, lines 1-12) wherein a butting wall (see fig. 4, projections 5,6 and aligning

rib 16) is disposed on either one of said case body (see fig. 2, projection 6 is on bottle 1) or said cap (see fig. 2, aligning rib 16 is on cap arrangement 8) so as to butt against the other one at a position in which screw engagement of said cap with the case body is complete and in which soft contact deformation of said gasket is controlled within a range of elastic deformation (see col. 2, lines 44-57 and col. 4, lines 28-35).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the ring-shaped gasket (packing arrangement 18) of Sekine in the cap of the cosmetic container of Marchant in order to maintain an effective seal as explicitly stated by Sekine (see col. 4, lines 10-13). It would have further been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the butting wall (see fig. 2, aligning rib 16 is on cap arrangement 8) of Sekine in the cap of the cosmetic container of Suzuki in order to control the screwed-on position of the cap on the case body as explicitly stated by Sekine (see col. 1, 36-42).

In Reference to Claim 2:

According to the modification of Marchant by Sekine as discussed in Claim 1, the refill case according to Claim 1 (see rejection of Claim 1 above), wherein rubber is used as a soft, elastic material for molding said gasket (see Sekine, col. 3, lines 45-47). Sekine discloses the gasket being formed of a soft synthetic resin. It is well known in the art that resins vary in properties from viscous liquids to rubberlike solids; hence, resin is giving the broadest reasonable interpretation as functioning in the same manner as a rubber in order to create a high sealing function for the cosmetic container as

explicitly taught by Sekine. It would have been an obvious matter of design choice based on the nature of the product to form the gasket of rubber or resin.

In Reference to Claims 4, 5, 8, and 10:

Marchant and Sekine fail to teach the following claimed limitations:

The refill case according to Claim 1 (Claim 2), wherein the short butting wall hangs down from underside of the roof and butts against the top surface of the brim of the middle plate, which is stored and held in the case body.

The refill case according to Claim 1 (Claim 2), wherein the butting wall butts against the top flat rim of the case body.

The butting wall feature as discussed in the claim has no function other than to control the maximum screwed-on position between the cap and case body of the cosmetic container. Marchant discloses that this can be accomplished by placing a stop (see fig. 2, stop 21) on each thread member (see fig. 2, thread members 20) of the case body (see col. 2, lines 43-48). Sekine also discloses that this objective can be obtained by projections and a rib situated on the cap and case body of the container (see col. 1, 36-42). Since the limitations in the above claims regarding the positioning of the butting wall accomplish no other purpose than what Marchant and Sekine have already disclosed, and because there appears to be no criticality with respect to the manner in which this objective is accomplished, the claims fail to patentably define over the prior art.

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6. Claims 1-3, 7, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,988,630 to Matsumoto (Matsumoto) in view of Applicant's prior art admission (APAA) in paragraphs [0002-0004] and Sekine.

In Reference to Claim 1:

Matsumoto teaches:

A refill case comprising: a case body (see fig. 1, container body 21); and a cap (see fig. 1, lid body 14 and container body 1), which is fitted around said case body detachably in screw engagement (see fig. 1, screw grooves 18, screw threads 23, and col. 8, lines 57-64)

Matsumoto fails to teach the following claimed limitation as admitted by APAA:

a middle plate in the shape of a bottomed short cylinder containing a cosmetic item and having outward brim along the upper periphery of said plate; a case body, which accepts and keeps said middle plate in a storage cylinder under the condition that said brim sits on the top flat rim of this storage cylinder; and a cap, which is fitted around said case body detachably in screw engagement, and which is used to seal said middle plate (paragraphs [0002-0004]);

Matsumoto fails to teach the following claimed limitation that is taught by Sekine:

a cap (see fig 1, cap arrangement 8), which is used to seal said middle plate through tight contact of said brim with a ring-shaped gasket (see fig. 1, packing arrangement 18) made of a soft, elastic material (see col. 3, lines 45-47), said gasket being embraced by the underside of roof (see

fig.1, closed top 11) and fitted thereto in an undetachable manner but in a state having play relative to said roof (see col. 2, lines 63-68 and col. 3, lines 1-12) wherein a butting wall (see fig. 4, projections 5,6 and aligning rib 16) is disposed on either one of said case body (see fig. 2, projection 6 is on bottle 1) or said cap (see fig. 2, aligning rib 16 is on cap arrangement 8) so as to butt against the other one at a position in which screw engagement of said cap with the case body is complete and in which soft contact deformation of said gasket is controlled within a range of elastic deformation (see col. 2, lines 44-57 and col. 4, lines 28-35).

It would have been obvious to one of ordinary skill in the art to have included a middle plate in the cosmetic container of Matsumoto in order to allow the container to be conveniently refilled with another cosmetic as admitted by APAA (Paragraphs [0002-0004]). It would have further been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the ring-shaped gasket (packing arrangement 18) of Sekine in the cap of the container of Matsumoto in order to maintain an effective seal as explicitly stated by Sekine (see col. 4, lines 10-13). It would have further been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the butting wall (see fig. 2, aligning rib 16 is on cap arrangement 8) of Sekine in the cap of the container of Matsumoto in order to control the screwed-on position of the cap on the case body as explicitly stated by Sekine (see col. 1, 36-42).

In Reference to Claim 2:



According to the modification of Matsumoto by APAA and Sekine as discussed in Claim 1, the refill case according to Claim 1 (see rejection of Claim 1 above), wherein rubber is used as a soft, elastic material for molding said gasket (see Sekine, col. 3, lines 45-47). Sekine discloses the gasket being formed of a soft synthetic resin. It is well known in the art that resins vary in properties from viscous liquids to rubberlike solids; hence, resin is giving the broadest reasonable interpretation as functioning in the same manner as a rubber in order to create a high sealing function for the cosmetic container as explicitly taught by Sekine. It would have been an obvious matter of design choice based on the nature of the product to form the gasket of rubber or resin.

In Reference to Claims 3 and 7:

According to the modification of Matsumoto by APAA and Sekine as discussed in Claim 1, the refill case according to Claim 1 (Claim 2), wherein the case body (see Matsumoto, fig. 1, container body 21) has a double wall structure (see Matsumoto, figs. 1 and 10, outer tube 22) in which a storage cylinder is folded at the top flat rim to form an outward screw cylinder (see Matsumoto, fig. 10, screw threads 23), which is used for the screw engagement with the cap (see Matsumoto, fig. 1, screw grooves 18 and col. 8, lines 57-64), and wherein a foot portion (see Matsumoto, fig. 9, unlabeled foot portion near locking part 28) is disposed at the lower end of said screw cylinder.

In Reference to Claim 9 and 11:

Matsumoto, APAA, and Sekine fail to teach the following claimed limitations:

The refill case according to Claim 3, wherein the short butting wall hangs down from underside of the roof and butts against the top surface of the brim of the middle plate, which is stored and held in the case body.

The refill case according to Claim 3, wherein the butting wall butts against the top flat rim of the case body.

The butting wall feature as discussed in the claim has no function other than to control the maximum screwed-on position between the cap and case body of the cosmetic container. Marchant discloses that this can be accomplished by placing a stop (see fig. 2, stop 21) on each thread member (see fig. 2, thread members 20) of the case body (see col. 2, lines 43-48). Sekine also discloses that this objective can be obtained by projections and a rib situated on the cap and case body of the container (see col. 1, 36-42). Since the limitations in the above claims regarding the positioning of the butting wall accomplish no other purpose than what Marchant and Sekine have already disclosed, and because there appears to be no criticality with respect to the manner in which this objective is accomplished, the claims fail to patentably define over the prior art.

***Allowable Subject Matter***

7. Claims 6 and 12-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The U.S. Patent No.'s 6336460, 6047710, 6923335, 5938016, and 5896866 have been included because they are generally representative of prior art cosmetic cases.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA L. LALLI whose telephone number is (571)270-5056. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ken Bomberg can be reached on (571) 272-4922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Kenneth Bomberg/  
Supervisory Patent Examiner, Art Unit 4124